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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,877	09/18/2003	Clement G. Eischen SR.	EIS 309	8893
23581	7590	03/21/2005	EXAMINER	
KOLISCH HARTWELL, P.C. 520 S.W. YAMHILL STREET SUITE 200 PORTLAND, OR 97204			ROANE, AARON F	
			ART UNIT	PAPER NUMBER
			3739	

DATE MAILED: 03/21/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/666,877	<b>Applicant(s)</b> EISCHEN, CLEMENT G.	
	<b>Examiner</b> Aaron Roane	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 January 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-10 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-4 and 6-10 are rejected under 35 U.S.C. 102(e) as being anticipated by Sheikh (USPN 6,589,272).

Regarding claim 1, Sheikh discloses a thermal pack apparatus (60), comprising:  
a shell (62) at least partially filled with a thermal material, the shell including an

outer perimeter, opposed sides of the outer perimeter each having a respective notch (first notch is located on the perimeter between straps 64 and 68 while the second notch is located on the opposite side of the perimeter between straps 66 and 70) formed therein, the notched being sized to enable an upper portion (the side of the 62 on which the upper straps 64 and 66 are located and which is separated from the lower portion by the axis defined by the notches and the hole) of the shell to be folded to form a first end configured to surround a limb on a first side of a joint, and a lower portion (the side of the 62 on which the upper straps 68 and 70) of the shell to be folded to form a second end configured to surround the limb on a second side of the joint, the shell further including a central portion (the area along the axis) configured to act as a hinge to enable flexing of the first end relative to the second end, to thereby accommodate movement of the joint, see col. 2-4 and figure 5.

Regarding claims 2 and 3, Sheikh further discloses that the notches are sized to accommodate a knee and/or elbow, see col. 3, lines 12-36.

Regarding claim 4, Sheikh further discloses that the thermal material is a gel, see claim 8.

Regarding claims 6 and 7, Sheikh discloses a first (64 and 66) and second (68 and 70) sets of fastening straps, see col. 4, lines 36-58 and figure 5.

Regarding claims 8-10, Sheikh discloses the claimed invention, see col. 2-5 and figure 5.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sheikh (USPN 6,589,272) in view of Cramer et al. (USPN 6,096,067).

Regarding claim 5, Sheikh discloses the claimed invention except for explicitly reciting that the gel is silica gel. Cramer et al. disclose a thermal wrap (10) and teach a wide variety of materials that serve as thermal materials including silica gel, see col. 8, lines 4-50. Therefore at the time of the invention it would have been obvious to one of ordinary skill in the art to modify the invention of Sheikh, as taught by Cramer et al., to use a wide variety of materials as thermal agents including gel silica.

***Response to Arguments***

Applicant's arguments filed 1/3/2005 have been fully considered but they are not persuasive.

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Regarding the remarks directed to the 102 rejections to claims 1-4 and 6-10 on page 2-4, disagrees completely with Applicant. Applicant asserts that Sheikh does not disclose that 62 is a shell at least partially filled with a thermal material. Again the examiner disagrees and will illustrate how Sheikh meets the claim. First, the shell (62) disclosed by Sheikh “may be molded to a more conforming shape by gathering portions of body portion 62 at seams 67 to form a shallow concavity or pocket within the body portion 62. After cold pack 12 is secured within hole 65 such that bladder 12a extends into the shallow concavity, apparatus 60 is applied to the user's left or right hip by wrapping and securing the upper straps 64,66 about the user's waist, and wrapping and securing the lower straps 68,70 about the user's leg on the side of the injured hip, thereby positioning cold pack 12 in direct proximity to the injured region,” see col. 4, lines 46-54. This illustrates how (62) forms a shell and how the thermal material in (12) is located within the cavity or concavity of the shell. Applicant may have in mind a shell in the form of a closed surface boundary, wherein the closed surface boundary has both an outer and inner surface and wherein the inner surface defines a pocket where the thermal material may be stored. As interpreted by the examiner, Sheikh does not disclose this kind of shell. However, this type of shell (a closed surface boundary shell) is not strictly positively recited, and the claim language allows for the broad interpretation that the examiner has applied.

Regarding the remarks directed to the 103 rejection to claim 5 on page 4-5, again Applicant is essentially refuting the use of Sheikh to reject the claims. Sheikh meets the claim subject matter of claims 1-4 and 6-10, including the use of a gel as a thermal material (see rejection to claim 4). However, Sheikh does not explicitly recite that the gel is silica gel.

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Cramer et al. disclose a thermal wrap (10) and teach a wide variety of materials that serve as thermal materials including silica gel, see col. 8, lines 4-50. Since the thermal material disclosed by Sheikh at least partially fills the shell, Applicant's arguments are not persuasive.

### *Conclusion*

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A.R. *A.R.*  
March 16, 2005

*Roy D. Gibson*  
ROY D. GIBSON  
PRIMARY EXAMINER